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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,317	01/19/2006	Brian Smith	1995.74509	7637
24978	7590	07/28/2009		
GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606			EXAMINER KATCHEVES, BASIL S	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 07/28/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/565,317	<b>Applicant(s)</b> SMITH, BRIAN	
	<b>Examiner</b> BASIL KATCHEVES	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) 25-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 29, 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The applicant has added new claims 25-30 and cancelled claims 9-24 in the amendment dated 6/3/09. Pending claims 1-8 and 25-30 are addressed below.

### ***Election/Restrictions***

Newly submitted claims 25-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The composite panel has two frame members attached to each other, each one has a web, and their webs protrude beyond the slab.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 1-8, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over O’Konski (U.S. Pat. 3,802,147) in view of Fu et al. (U.S. Pat. 5,494,513) as in the previous action.**

- a. **Claims 1-3, 29 and 30.** O’Konski discloses a prefab panel comprising:
- i. A frame including a plurality of spaced apart frame members 10, shown as a C-channel having a first flange extending perpendicularly from an end of the web portion including tab 11 and a similarly extending second flange from an opposing end of the web;
  - ii. A reinforcing layer 13 fastened to the flange of the frame member via tongue 12; and
  - iii. A concrete slab 14, wherein the slab 14 has a front and rear face, and further wherein the reinforcing layer 13 and flange, shown at 11 and 12, are embedded in the slab 14, and another portion of the frame protrudes from the rear face of the slab 14 (Figs. 1-3).

O’Konski lacks wherein the concrete is aerated and has a density of between 400-1760 kg/m<sup>3</sup>. Fu et al. teaches it is known to aerate concrete

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compositions resulting in a density within the claimed range to provide a lightweight building material (Fu Col. 3 Lines 58-64). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the concrete of O'Konski with aerated concrete having a density within the claimed range to provide a lighter weight building material without sacrificing structural integrity.

b. **Claim 4.** O'Konski discloses wherein the first flange includes at least one tab 11 and tab-opening, shown as the void defined by the tab 11, wherein the concrete slab 14 extends through the opening (Figs. 1 and 2).

c. **Claim 5.** O'Konski discloses wherein the reinforcing layer 13 includes a slit and expanded metal lath (Col. 4 Lines 36-37).

d. **Claim 6.** O'Konski discloses wherein the panel includes at least one opening partially bounded by the frame members 10, interpreted as the void between slabs 14 and 16 (See Fig. 2).

e. **Claims 7 and 8.** O'Konski discloses wherein the panel includes at least one outer member 18 removably attached before and permanently attached after being spot welded (Col. 5 Lines 28-32) to the frame and bounding at least one edge of the panel (Fig. 3).

f.

### **Response to Arguments**

Applicant's arguments filed 6/2/09 have been fully considered but they are not persuasive. The applicant argues the combination of references, O'Konski in view of

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Fu, is not obvious. However, the applicant should note in the last paragraph of column 1, Fu discloses this density. This is a common feature in concrete and taught by Fu.

The applicant also argues the intended use of the panel and it would not be obvious to combine the references because of the intended use. The applicant should note that the structural limitations, as claimed, are met by the combination of references and therefore they meet the limitations of the claimed subject matter of the instant

application. The reasons for using lightweight concrete may be many. For example,

lightweight concrete would be preferred in any transportable structure, or would be

obvious regarding the use of the panel. For example, a panel supporting less load

would not need to be as strong as a panel supporting a heavy load. The applicant also

argues that the tabs 11, 12, 15 and 19 extend from the flanges and are embedded in

the concrete, but the flanges are not embedded in the concrete. The applicant should

note that the tabs are part of the flanges. Also, the applicant claims, in claim 4, that the

flange includes the tab. This is addressed in the rejection above and as such, the

flange would be embedded in the concrete panel since it is part of the tab. If the flange

was not embedded in any manner to the slab, the panel of O'Konski would clearly fall

apart. The applicant also argues new claim 25. This is mute as it has been restricted

by original presentation. Regarding the affidavit filed on 6/2/09 under 37 CFR 1.132 has

been considered but is ineffective to overcome the O'Konski and Fu references since

they meet the structural limitations of the instant application as claimed.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot, can be reached at (571) 272-6777.

/Basil Katcheves/

Primary Examiner, Art Unit 3635